REMARKS:

Claims 1-43 are currently pending in the application.

Claims 15-28 stand rejected under 35 U.S.C. § 101.

Claims 1, 4, 5, 8-13, 15, 18, 19, 22-27, 29-30, 33, 34, and 37-42 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,774,868 to Cragun et al. *("Cragun")*.

Claims 6, 7, 14, 20, 21, 28, 35, 36, and 43 stand rejected under 35 U.S.C. § 103(a) over *Cragun*.

Claims 2, 3, 16, 17, 31, 32 stand rejected under 35 U.S.C. § 103(a) over *Cragun* in view of U.S. Patent No. 6,266,649 to Linden et al. *("Linden")*.

Applicants respectfully submit that all of Applicants arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicants have merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicants reserve the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicants further respectfully submit that by not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are considered sufficient to overcome the Examiner's rejections. In addition, Applicants reserve the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 101:

Claims 15-28 stand rejected under 35 U.S.C. § 101 as allegedly being directed towards non-statutory subject matter.

Although Applicants believe Claims 15-28 are directed to patentable subject matter without amendment, Applicants have amended Applicants claims to more particularly point out and distinctly claim Applicants invention. By making these amendments, Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these

claims under 35 U.S.C. § 101, as set forth in the new grounds of rejection. In addition, Applicants respectfully submit that the amendments to Applicants claims are not necessitated by any prior art and are unrelated to the patentability of the present invention.

Applicants respectfully submit that Claims 15-28 are directed to statutory subject matter. Applicants further respectfully submit that Claims 15-28 are in condition for allowance. Therefore, Applicants respectfully request that the rejection of Claims 15-28 under 35 U.S.C. § 101 be reconsidered and that Claims 15-28 be allowed.

REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1, 4, 5, 8-13, 15, 18, 19, 22-27, 29-30, 33, 34, and 37-42 stand rejected under 35 U.S.C. § 102(b) over *Cragun*.

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628,631 (Fed. Cir. 1987). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

Applicants respectfully submit that *Cragun* fails to disclose each and every limitation recited by Claims 1, 4, 5, 8-13, 15, 18, 19, 22-27, 29-30, 33, 34, and 37-42. Applicants further respectfully submit that Claims 1, 4, 5, 8-13, 15, 18, 19, 22-27, 29-30, 33, 34, and 37-42 patentably distinguish over *Cragun*. Thus, Applicants respectfully traverse the Examiners rejection of Claims 1, 4, 5, 8-13, 15, 18, 19, 22-27, 29-30, 33, 34, and 37-42 under 35 U.S.C. § 102(b) over *Cragun*.

***Cragun* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

For example, with respect to amended independent Claim 1, this claim recites:

> A computer-implemented system for rendering content according to availability data for at least one item, comprising:
>
> a server configured to receive a content request from a user in a current interactive session and, in response to the user-supplied content request, to retrieve the user-requested content;

a rendering engine coupled with the server and configured to identify at least one rule within the user-requested content and concerning the item; and

a rules engine coupled with the rendering engine and configured to:

generate at least one availability request corresponding to the rule and concerning the item;

receive availability data for the item;

retrieve additional content according to the availability data for the item, the additional content being selected from among one or more stored content elements that concern the item; and

communicate the additional content concerning the item to the rendering engine for incorporation in the user-requested content;

the rendering engine further configured to render the user-requested content, including the additional content concerning the item;

the server further configured to communicate the rendered user-requested content to the user in the current interactive session to satisfy the user-supplied content request.

In addition, *Cragun* fails to disclose each and every limitation of independent Claims 15 and 29-30.

To reject independent Claim 1, the Examiner asserts that both the automatic sales promotion selection system and the neural network purchase advisor subsystem in *Cragun* can be properly considered ***a rules engine***, as recited in independent Claim 1. The Examiner further asserts that the output device in *Cragun* can be properly considered ***a rendering engine***, as recited in independent Claim 1. Applicants respectfully disagree.

The automatic sales promotion selection system and the neural network purchase advisor subsystem in *Cragun* cannot be properly considered ***a rules engine***, as recited in independent Claim 1. To be properly considered ***a rules engine,*** as recited in independent Claim 1, the automatic sales promotion selection system and the neural network purchase advisor subsystem in *Cragun* would at a minimum, as recited in independent Claim 1, have to:

- ***generate at least one availability request corresponding to the rule and concerning the item;***
- ***receive availability data for the item;***
- ***retrieve additional content according to the availability data for the item, the additional content being selected from among one or more stored content elements that concern the item; and***

- ***communicate the additional content concerning the item to the rendering engine for incorporation in the user-requested content.***

However, nowhere does *Cragun* disclose, teach, or suggest that the automatic sales promotion selection system or the neural network purchase advisor subsystem in *Cragun* ***generates at least one availability request corresponding to the rule and concerning the item***, as recited in independent Claim 1. In *Cragun,* a computer system merely analyzes collected purchase information for a customer to segment the items purchased into purchase classes of items ordinarily purchased together and uses a neural network purchase advisor subsystem to identify items missing from a purchase that are members of a purchase class otherwise represented in the purchase. (Column 4, Lines 12-15). The neural network purchase advisor subsystem in *Cragun* makes use of probability threshold values that limit a number of items identified as missing from a purchase to only items having a sufficiently high probability of actually belonging to the purchase class. (Column 4, Lines 15-18; Column 5, Lines 49-56). As discussed above, an output device then generates a purchase suggestion, an automatically dispensed coupon, or other sales promotion indicating the identified missing items. (Column 4, Lines 18-22). Nothing in *Cragun* discloses, teaches, or even suggests that, to identify items missing from a purchase to generate a sale promotion, the automatic sales promotion selection system or the neural network purchase advisor subsystem in *Cragun* ***generates*** **any** ***availability request,*** much less ***at least one availability request corresponding to the rule and concerning the item***, as recited in independent Claim 1. Similarly, nothing in *Cragun* discloses, teaches, or even suggests that, to identify items missing from a purchase to generate a sale promotion, the automatic sales promotion selection system or the neural network purchase advisor subsystem in *Cragun* ***receives availability data for the item***, as recited in independent Claim 1.

Because *Cragun* fails to disclose, teach, or suggest ***generating at least one availability request corresponding to the rule and concerning the item*** and also fails to disclose, teach, or suggest ***receiving availability data for the item,*** as recited in independent Claim 1, *Cragun* also necessarily fails to disclose, teach, or suggest ***retrieving additional content according to the availability data for the item, the additional content being selected from among one or more stored content elements that concern the item***, as recited in independent Claim 1.

The output device in *Cragun* cannot be properly considered ***a rendering engine,*** as recited in independent Claim 1. To be properly considered ***a rendering engine,*** as recited in independent Claim 1, the output device in *Cragun* would at a minimum, as recited in independent Claim 1, have to:

- ***identify at least one rule within the user-requested content and concerning the item; and***
- ***render the user-requested content, including the additional content concerning the item that has been retrieved according to the availability data for the item and selected front among one or more stored content elements that concern the item.***

Nowhere does *Cragun* disclose, teach, or suggest that the output device in *Cragun* ***identifies at least one rule within the user-requested content and concerning the item***, as recited in independent Claim 1. As discussed above, the output device in *Cragun* is merely a printer or display terminal that receives item identifiers of likely purchases and generates a purchase suggestion, an automatically dispensed coupon, or another sales promotion. *Cragun* makes no disclosure, teaching, or suggestion whatsoever that the output device in *Cragun* in any way ***identifies at least one rule,*** much less at least one rule ***within the user-requested content,*** as recited in independent Claim 1. Moreover, nowhere does *Cragun* disclose, teach, or suggest that the output device in *Cragun* ***renders the user-requested content, including the additional content concerning the item,*** as recited in independent Claim 1. Even assuming for the sake of argument that generating a purchase suggestion, an automatically dispensed coupon, or another sales promotion could be properly considered ***rendering content,*** as recited in independent Claim 1, *Cragun* would still fail to disclose, teach, or suggest ***rendering the user-requested content, including the additional content concerning the item,*** as recited in independent Claim 1. Nothing in *Cragun* even suggests that a purchase suggestion, an automatically dispensed coupon, or another sales promotion from the output device in *Cragun* is ***user-requested,*** as recited in independent Claim 1. In fact, **Cragun teaches away from output of the output device in Cragun being *user-requested*.** As Applicants have pointed out, the automatic sales promotion selection system in *Cragun* collects purchase transaction data, analyzes the data relating to a particular customer purchase, and selects a sales promotion calculated to result in additional purchases automatically and without the customer knowing that such a process is taking place. Therefore, a purchase suggestion, an automatically

dispensed coupon, or another sales promotion from the output device in *Cragun* could not possibly be ***user-requested***, as recited in independent Claim 1.

Moreover, because as discussed above *Cragun* fails to disclose, teach, or suggest a ***rendering engine*** and ***user-requested content***, as recited in independent Claim 1, *Cragun* also necessarily fails to disclose, teach, or suggest ***communicating the additional content concerning the item to the rendering engine for incorporation in the user-requested content*** as recited in independent Claim 1.

The Office Action Fails to Properly Establish a *Prima Facie* case of Anticipation over *Cragun*

Applicants respectfully submit that the allegation in the present Office Action that *Cragun* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Cragun* is considered to anticipate all of the limitations in Claims 1, 4, 5, 8-13, 15, 18, 19, 22-27, 29-30, 33, 34, and 37-42. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference***. MPEP § 2131. (Emphasis Added).

Applicants respectfully point out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). Applicants respectfully submit that ***the Office Action has failed to establish a prima facie case of anticipation in Claims*** 1, 4, 5, 8-13, 15, 18, 19, 22-27, 29-30, 33, 34, and 37-42 ***under 35 U.S.C. § 102 with respect to*** *Cragun* ***because*** *Cragun* ***fails to identically disclose each and every element of Applicants claimed invention, arranged as they are in Applicants claims***.

Applicant's Claims are Patentable over *Cragun*

With respect to independent Claims 15 and 29-30 these claims include limitations similar to those discussed above in connection with independent Claim 1. Thus, independent Claims 15 and 29-30 are considered patentably distinguishable over *Cragun* for at least the reasons discussed above in connection with independent Claim 1.

Furthermore, with respect to dependent Claims 4, 5, 8-13, 18, 19, 22-27, 33, 34, and 37-42: Claims 4, 5, and 8-13 depend from independent Claim 1; dependent Claims 18, 19, and 22-27 depend from independent Claim 15; and dependent Claims 33, 34, and 37-42 depend from independent Claim 29 and are also considered patentably distinguishable over *Cragun*. Thus, dependent Claims 4, 5, 8-13, 18, 19, 22-27, 33, 34, and 37-42are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, Applicants respectfully submit that Claims 1, 4, 5, 8-13, 15, 18, 19, 22-27, 29-30, 33, 34, and 37-42 are not anticipated by *Cragun*. Applicants further respectfully submit that Claims 1, 4, 5, 8-13, 15, 18, 19, 22-27, 29-30, 33, 34, and 37-42 are in condition for allowance. Thus, Applicants respectfully request that the rejection of Claims 1, 4, 5, 8-13, 15, 18, 19, 22-27, 29-30, 33, 34, and 37-42 under 35 U.S.C. § 102(b) be reconsidered and that Claims 1, 4, 5, 8-13, 15, 18, 19, 22-27, 29-30, 33, 34, and 37-42 be allowed.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 6-7, 14, 20-21, 28, 35-36, and 43 presently stand rejected under 35 U.S.C. § 103(a) over *Cragun*. Claims 2-3, 16-17, and 31-32 presently stand rejected under 35 U.S.C. § 103(a) over *Cragun* in view of *Linden*.

Applicant's Claims are Patentable over the Proposed *Cragun-Linden* Combination

As discussed above, amended independent Claims 1, 15, 29, and 30 are considered patentably distinguishable over *Cragun*.

Therefore, dependent Claims 2-3, 6-7, 14, 16-17, 20-21, 28, 31-32, 35-36, and 43 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicants respectfully submit that Claims 2-3, 6-7, 14, 16-17, 20-21, 28, 31-32, 35-36, and 43 are not rendered obvious by the proposed combination of *Cragun* and *Linden*. Applicants further respectfully submit that Claims 2-3, 6-7, 14, 16-17, 20-21, 28, 31-32, 35-36, and 43 are in condition for allowance. Thus, Applicants respectfully request that the rejection of Claims 2-3, 6-7, 14, 16-17, 20-21, 28, 31-32, 35-36, and 43 under 35 U.S.C. §

103(a) be reconsidered and that Claims 2-3, 6-7, 14, 16-17, 20-21, 28, 31-32, 35-36, and 43 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

3 February 2009
Date

/Steven J. Laureanti/signed
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